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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,103	01/20/2004	Sylvic Gauthier	6674-0037-1	4659

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O'SHEA, GETZ & KOSAKOWSKI, P.C.
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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1794

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12/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,103	Applicant(s) GAUTHIER ET AL.	
	Examiner Thao T. Tran	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,22-32 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,22-32 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/28/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the Amendment filed on 9/25/2007.
2. Claims 1-7, 22-32, 34-37 are currently pending in this application. Claims 1, 3, 5, 7, 35, 37 have been amended. Claims 8-21, 33, and 39 have been canceled.
3. In view of the previous Office action, the double patenting rejections are sustained. The previous prior art rejections have been withdrawn.
4. In light of newly found prior art, a new rejection of the claims is as set forth below.

Claim Objections

5. Claims 26 and 30 are objected to because of the following informalities: in claim 26, line 6 and in claim 30, line 2, a leather material should be changed to --leather--. Appropriate correction is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 3-6, and 22-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, and 9 of Copending Application, Serial No. 10/762,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other.

Claims 1-2, 4-7, and 9 of the copending application recite all of the limitations in instant claims 1, 3-6, and 22-33. Moreover, claims 1 and 6 of the copending application disclose an underlayer and a backer in addition to the core layer and the first decorative layer. Thus, claims 1 and 6 of the copending application are narrower in scope than the instant claims, rendering them obvious over each other.

8. Claims 1-7, 22-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 whether alone, or in view of Lindenfeiser '325 or Albrinck '974, or in view of Hiers et al. (US Pat. 4,132,821). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims is narrower than that of the instant claims, rendering them obvious over each other.

In regards to instant claims 1-6, claims 1-5 of the patent contain all the limitations in the instant claims. However, the patented independent claims 1, 2, and 3 include the flexible backing layer in addition to the leather layer and the decorative layer of instant claim 1. Thus, the scope of the instant claims embraces that of the patented claims, rendering them obvious over each other.

In regards to claims 7 and 22-33, the patented claims do not specify the resin impregnating the cellulose paper or the weight percent of the resin.

Lindenfeiser discloses a laminate comprising a core sheet impregnated with 33-35% melamine-formaldehyde resin (see col. 2, ln. 15-32). Albrinck discloses a laminate having a core sheet impregnated with 25-35% melamine-formaldehyde resin (see col. 4, ln. 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the amounts of melamine-formaldehyde resin in the core sheet, as taught by Lindenfeiser or Albrinck, in the laminate of the patented claims, to impart hardness, abrasion and solvent resistance, thus durability to the layer.

In regards to claims 34-39, the patented claims do not specify the leather including animal hide.

Hiers discloses the use of leather containing animal hides (see col. 1, ln. 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the laminate of the patented claims, because leather containing animal hides as well as artificial leather have been conventionally used in the art of decorative articles. Moreover, natural leather is more biodegradable and environmentally friendly.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (US Pat. 2,721,817).

Hastings discloses a decorative laminate, comprising a sheet of leather 10 and a composite layer having a support layer 12, and an adhesive layer 14 (see Fig. 2). The support layer is a sheet of paper or regenerated cellulose, whereas the adhesive layer comprises phenol formaldehyde resin (see paragraph bridging col. 3 & 4; the claim).

Although Hastings does not teach the cellulose sheet to be impregnated with the phenol formaldehyde, it has been held that making integral of separate parts a prima facie case of obviousness.

11. Claims 1-2, 4-6, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McQuade (US Pat. 3,698,978) in view of Hastings et al. (US Pat. 2,721,817).

McQuade discloses a high pressure laminate comprising core sheets, a decorative print sheets, and overlay sheets. The core sheets are made of paper and impregnated with phenolic resin. The decorative print sheet and the overlay sheets are cellulosic and impregnated with melamine resin. The decorative sheet can be a simulated leather (see Figs 1-2; col. 1, ln. 24-35; col. 2, ln. 36-46; col. 3, ln. 20-50; Examples 1-2; claims 1-2). McQuade further teaches a separator with a siliconized paper, attached to the print sheet (see col. 4, ln. 28-29).

McQuade, however, does not teach the decorative sheet to be essentially leather.

Hastings discloses a decorative laminate, comprising a sheet of leather 10 and a composite layer having a support layer 12, and an adhesive layer 14 (see Fig. 2). The support layer is a sheet of paper or regenerated cellulose, whereas the adhesive layer comprises phenol formaldehyde resin (see paragraph bridging col. 3 & 4; the claim).

Therefore it would have been obvious to one of ordinary skill in the art to have used leather, as taught by Hastings, in the decorative layer of McQuade because simulated and natural leathers have been used as alternatives in the prior art.

12. Claims 1-2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher (US Pat. 3,700,537) in view of Hastings et al. (US Pat. 2,721,817).

Scher discloses a laminate, comprising core sheets of kraft paper; a print sheet and an overlay sheet, both made of alpha-cellulose paper. The core sheets are impregnated with a phenol-formaldehyde resin, whereas the print or decorative sheet and the overlay sheet are impregnated with melamine-formaldehyde resin. (See col. 1, ln. 55-71). The print sheet is with decorative printing, and is simulated leather (see col. 2, ln. 20-21), thus meeting the requirements of the presently claimed decorative layer. The thickness of the decorative sheet is greater than 7 mils (greater than 0.18 mm), which meets the requirements of the presently claimed thickness.

Hastings discloses a decorative laminate, comprising a sheet of leather 10 and a composite layer having a support layer 12, and an adhesive layer 14 (see Fig. 2). The support layer is a sheet of paper or regenerated cellulose, whereas the adhesive layer comprises phenol formaldehyde resin (see paragraph bridging col. 3 & 4; the claim).

Therefore it would have been obvious to one of ordinary skill in the art to have used leather, as taught by Hastings, in the decorative layer of Scher because simulated and natural leathers have been used as alternatives in the prior art.

13. Claims 3, 7 and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McQuade or Scher in view of Hastings and further in view of Lindenfeiser et al. (US Pat. 2,732,325) or Albrinck et al. (US Pat. 3,589,974).

McQuade, Scher, and Hastings are as set forth in claims 1-2, 4-6 above and incorporated herein.

Neither McQuade nor Scher discloses the amount of melamine-formaldehyde resin in the core sheet.

Lindenfeiser discloses a laminate comprising a core sheet impregnated with 33-35% melamine-formaldehyde resin (see col. 2, ln. 15-32). Albrinck discloses a laminate having a core sheet impregnated with 25-35% melamine-formaldehyde resin (see col. 4, ln. 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the amounts of melamine-formaldehyde resin in the core sheet, as taught by Lindenfeiser or Albrinck, in the laminate of McQuade or Scher, to impart hardness, abrasion and solvent resistance, thus durability to the layer.

With respect to the bonded leather, it has been within the skill in the art that bonded leather and simulated leather have been conventionally used as alternative materials. Therefore, it's the examiner's position that it would have been prima facie obvious to substitute one for another and would have given the same results.

14. Claims 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McQuade or Scher in view of Hastings and further in view of Hiers et al. (US Pat. 4,132,821).

15. McQuade, Scher, and Hastings are as set forth in claims 1-2, 4-6 above and incorporated herein.

Neither McQuade nor Scher discloses the leather to include animal hide.

Hiers discloses the use of leather containing animal hides (see col. 1, ln. 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the laminate of McQuade or Scher. The reason is because leather containing animal hides as well as simulated leather have been conventionally used in the art of decorative articles. Moreover, natural leather is more biodegradable and environmentally friendly.

16. Claims 1-7, 22-32, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (US Pat. 6,423,167) in view of Hastings et al. (US Pat. 2,721,817). The Palmer reference is cited in the IDS of 6/28/2007.

Palmer discloses a decorative laminate, comprising a core layer, a decorative pattern layer, an overlay layer, and a release layer (see Fig. 2). The core layer comprises a plurality of kraft paper sheets that are impregnated with phenol formaldehyde (see col. 1, ln. 34-51). The decorative layer is cellulose paper impregnated with melamine formaldehyde resin and contains natural leather (see paragraph bridging col. 1 & 2).

Palmer, however, does not teach the decorative layer to be essentially leather.

Hastings discloses a decorative laminate, comprising a sheet of leather 10 and a composite layer having a support layer 12, and an adhesive layer 14 (see Fig. 2). The support layer is a sheet of paper or regenerated cellulose, whereas the adhesive layer comprises phenol formaldehyde resin (see paragraph bridging col. 3 & 4; the claim).

Therefore it would have been obvious to one of ordinary skill in the art to have used leather, as taught by Hastings, in the decorative layer of Palmer because leather and cellulose paper have been used as alternatives in the art of making decorative laminates.

Response to Arguments

17. Applicant's arguments with respect to the rejections of the claims in the prior Office action have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Thao T. Tran
Primary Examiner
Art Unit 1794

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